

## **Remarks/Arguments**

Claims 1-12 and 14 are pending in the application. Claims 1-6 and 14 have been identified by the status, "Withdrawn," based on the Office's position that they are directed to a non-elected invention. Claims 7-12 are therefore currently being examined in the case.

### **Response to Election By Original Presentation**

The Office has withdrawn claims 1-6 and 14 from consideration as allegedly being directed to a non-elected invention. The Office asserts that pending "Claims 1-6 and 14, which are drawn to a single step depolymerization process, are obviously different from the invention of original Claims 1-6 being drawn to a process for preparing a solution of a polysaccharide since the inventions have different designs and modes of operation." (Office Action, page 2) (citations omitted).

Applicants respectfully submit that the Office's withdrawal of claims 1-6 and 14 from consideration is improper. More specifically, pending claims 1-6 and 14 are not drawn to an "obviously" different invention than claims 1-6 as originally presented. Originally presented claims 1-6 were drawn to a "process for preparing a solution of a polysaccharide or polysaccharide ether. . ." In the original claims, the process included the step of "adding to an aqueous medium a polysaccharide ether and an alkaline depolymerization agent." Currently pending claim 1 is directed to a "single step depolymerization process for preparing a solution of polysaccharide or polysaccharide ether . . ." In pending claim 1, the depolymerization process includes the step of "adding to an aqueous medium, under depolymerization conditions, a polysaccharide or polysaccharide ether and from 2 to 10 wt% an alkaline depolymerization agent, based on the weight of said polysaccharide or polysaccharide ether . . ."

Contrary to the Office's assertions, Applicants submit that both original claims 1-6 and currently pending claims 1-6 and 14 are each drawn to the same invention. As is evident based on both the originally filed claims and the amended claims, the components used in the process and the process steps have not been altered by

Applicants' most recent amendment. Rather, currently pending claims 1-6 and 14 were amended to merely further define the process for preparing a solution of polysaccharide or polysaccharide ether by more specifically setting forth the conditions for carrying out the claimed process. Applicants submit that even as originally filed, claims 1-6 would have been understood by one of ordinary skill in the art as being directed to a depolymerization process for preparing a solution of polysaccharide or polysaccharide ether, based on the specification and the recitation in originally filed claim 1 of adding of an alkaline depolymerization agent as part of the claimed process.

Consequently, the Office's characterization that originally presented claims 1-6 and currently pending claims 1-6 and 14 are directed to different inventions is misguided. Accordingly, Applicants submit that the withdrawal of claims 1-6 and 14 is improper and the reinstatement of these claims for consideration is respectfully requested.

#### **Rejection of Claims 7-12 under Section 112, first paragraph**

Claims 7-12 stand rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Office alleges that claims 7-12 contain new matter based on the assertion that the specification does not provide support for "a solid composition comprising a polysaccharide ether and from 2 to 10% of an alkaline depolymerization agent, based on the weight of said polysaccharide ether." (emphasis is original) (Office Action, page 3).

Applicants respectfully disagree. As recognized by the Office, the specification, at page 10, 4<sup>th</sup> paragraph, indicates that the claimed "amount of alkaline depolymerization agent may be present with polysaccharide ether in an aqueous solution." The Office incorrectly concludes, however, that the specification does not indicate that the solid composition comprises an alkaline depolymerization agent in an amount ranging from 2 to 10%. Applicants submit that the Office has apparently overlooked that the claimed "2 to 10% of alkaline depolymerization agent" is "based on the weight of said polysaccharide or polysaccharide ether." That is, the amount of alkaline depolymerization agent is not based on a total weight of the aqueous

composition, which would include the aqueous medium, polysaccharide or polysaccharide ether and the alkaline depolymerization agent. In such a case, the amount of alkaline depolymerization agent in the aqueous solution may differ from the amount of alkalkine depolymerization agent in the solid composition.

Contrary to the Office's rejection, however, what is claimed is that the amount of alkaline depolymerization agent is based on the weight of the polysaccharide or polysaccharide ether; thus, the amount of depolymerization agent present is the same for either the aqueous solution or the solid composition. For example, as set forth in Example 1,

In a stirred stainless steel reactor, 32.5 g of CMC (Akucell AF 0305, ex Akzo Nobel, having a water content of 7.6% and a viscosity of 4,757 mPa·s for a 6 wt% aqueous solution of said CMC when measured with a Brookfield LV rheometer operating at 10 rpm and 25°C) were dissolved in 467.5 g of tap water at 65°C giving a 6 wt% aqueous CMC solution. To this aqueous solution, 0.60 g of sodium percarbonate (ex Aldrich), i. e. 2 wt% relative to the amount of CMC, was added in one minute under vigorous stirring. (emphasis added) (Specification, page 11, lines 22-28).

According to Example 1, the amount of sodium percarbonate (alkaline depolymerization agent) relative to the amount of CMC (polysaccharide ether) is 2 wt%. That is, the amount of alkaline depolymerization agent is 2wt%, based on the weight of the polysaccharide ether. This is calculated in Example 1 based on 0.60 g of sodium percarbonate divided by 32.5 g of CMC. Applicants submit, therefore, that regardless whether the composition is a solid composition or an aqueous solution in which the solid composition components are dissolved in 467.5 g of tap water, the value for the sodium percarbonate is still 2 wt%, based on the weight of the CMC.

Accordingly, Applicants submit that the originally filed specification does, at the very least at page 10, 4<sup>th</sup> paragraph, support the feature of: "a solid composition comprising a polysaccharide ether and from 2 to 10 wt% of an alkaline depolymerization agent, based on the weight of said polysaccharide ether," as recited in claims 7-12. Reconsideration and withdrawal of the Section 112, first paragraph rejection, is therefore respectfully requested.

## **Conclusion**

In view of the arguments set forth above, Applicants submit that the pending application is in condition for allowance. Notice to this effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, enclosed in a thin oval border. The signature reads "Ralph J. Mancini".

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